



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/650,248

08/28/2003

James Guo

7192

7590

07/12/2004

James Guo
171 Orsi Cir.
San Francisco, CA 94124

EXAMINER

WOOD, KIMBERLY T

ART UNIT

PAPER NUMBER

3632

DATE MAILED: 07/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/650,248

Applicant(s)

GUO ET AL.

Examiner

Kimberly T. Wood

Art Unit

3632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 23 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/23/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 3632

This is the first office action for serial number 10650248.

Attachment to Office Action: Information to Pro Se Inventors Regarding responses to Office Actions

INTRODUCTION

An examination of this application reveals that applicant may be unfamiliar with patent prosecuting procedure. While an inventor may prosecute the application, lack of skill in this field usually acts as a liability in affording the maximum protection for the invention disclosed.

Applicant is advised to secure the services of a registered patent attorney or agent to prosecute the application. The value of a patent is largely dependent upon skillful preparation and prosecution. Although the services of a registered patent attorney or agent is advised, the Office cannot aid in selecting an attorney or agent. 37 C.F.R. § 1.31; M.P.E.P. § 401. However, Applicant is encouraged to peruse the publication entitled "Attorneys and Agents Registered to Practice Before the U.S. Patent and Trademark Office." This publication is for sale by the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

DISCUSSION

The following discussion provides general information for Applicant's benefit regarding an applicant's response, new matter, the period for response, and the certificate of mailing.

I. Response by Applicant

The applicant **MUST** respond to every ground of rejection and objection made in an Office action. 37 C.F.R. § 1.111. The applicant will generally present arguments that the examiner's rejections or objections were made in error; or amend the specification, drawings, and/or claims to overcome the rejection or objection. Amendments to the application may not introduce new matter. 37 C.F.R. § 1.118.

Unless the Office explicitly requests the return of a paper, all papers mailed to the applicant are intended to be kept by the applicant for his own records. The response must be signed by **ALL** applicants. 37 C.F.R. § 1.33. The response must be identified by the Serial Number of the Application, the Art Unit, and the name of the examiner. An example follows:

Appl. No. : XX/YYY,YYY
Applicant : James Q. Inventor
Filed: April 19, 2003
Title : Bucket with Handle
Art Unit: 3632
Examiner:: John Doe

A. Arguments

Should the applicant disagree with the examiner's position, the applicant should distinctly and specifically point out the supposed errors in the examiner's action with arguments under the heading "Remarks" in the response. 37 C.F.R. § 1.111. In addition, the applicant must discuss the references cited by the examiner that

Art Unit: 3632

explain how the claims avoid the references or patentably distinguish from them. *Id.*

B. Amendments to the Specification

An amendment to the specification may remove a rejection or objection. Any amendment to the specification must be presented as a list of additions and deletions, referring to the passages in question by page and line numbers. 37 C.F.R. § 1.121.

An amendment to the specification should appear as follows:

Please replace the paragraph beginning at page 5, line 15, with the following rewritten paragraph:

I -In the construction of the bucket of this invention, various materials have been selected and which offer a number of diverse properties and allow for varied functions of the article. For caustic solutions, the bucket can be made of a durable polymer plastic material. Where an aesthetic appeal is desired, the bucket can be any of one of many attractive colors. The following listing of properties serves to define possible uses for the buckets.--

Please add the following new paragraph after the paragraph ending on line 20 of page 6:

-- An optional feature of the articles of the invention is the addition of a tetrafluoroethylene coating to the bucket to provide protection from any contents which might be caustic. The coating can be provided to the surface during the manufacturing process or can be added in a later step.--

C. Amendments to the Claims

An amendment to the claim may remove a rejection or objection. This listing of claims will replace all prior versions, and listings, of claims in the application:

Art Unit: 3632

Listing of Claims:

Claims 1-4 (canceled)

Claim 5 (original): A bucket with a black handle.

Claim 6 (original): A bucket of claim 5 wherein the handle is metal.

Claim 7 (withdrawn)

Claim 8 (currently amended): A bucket made of ~~yellow~~ green plastic.

Claim 9 (previously amended): A bucket made of aluminum-coated galvanized metal.

Claim 10 (previously added): A bucket having a circumferential upper lip.

Claim 11 (new): A plastic bucket having a blue handle.

D. Drawing Corrections

Finally, correction of the drawings may remove a rejection or objection. Changes to the drawings are submitted as proposed drawing corrections and can be made only with permission of the Office. 37 C.F.R. § 1.123. Proposed drawing corrections should be filed with the response, but should be a separate paper. M.P.E.P. § 608.02(r). The proposed corrections should appear in red ink in the drawings. M.P.E.P. § 608.02(v).

Art Unit: 3632

II. New Matter

As previously mentioned, no amendment to the specification, claims, or drawings may introduce new matter. 37 C.F.R. § 1.118. "New matter" constitutes any material which meets the following criteria:

- (1) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and
- (2) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

See M.P.E.P. § 706.03(o). For example, in the amendment to the claim discussed above, the new limitation of "four legs" would not constitute new matter if the specification or drawings originally described the inclusion of four legs on the chair.

III. Period For Response

An Office action generally sets a time period in which the applicant has to respond to every rejection and objection (called a shortened statutory period). 37 C.F.R. § 1.134. This time period for response appears on the cover letter (form PTO-326) of the Office action. Usually, a 3 month shortened statutory period is set. M.P.E.P. § 710.02(b). The applicant's response must be received

Art Unit: 3632

within the time period listed on the cover letter, or the application will be held abandoned. 37 C.F.R. § 1.135.

Currently, the Office allows the time period for response to be extended past the shortened statutory period up to a maximum of 6 months (called the maximum 6 month statutory period). In order to extend the period of response past the shortened statutory period, a request for an extension of time and payment of the appropriate fee is required. 37 C.F.R. § 1.136. The request must state that it is for "an extension of the period for response under 37 C.F.R. § 1.136(a)." The following table lists the required fees for extensions of the shortened statutory period:

Months Past Response Date	Fee Due (Small / Large Entity)
Response within Time Allowed	None / None
1	\$55 / \$110
2	\$205 / \$410
3	\$465 / \$930
4	\$725 / \$1,450
5	\$985 / \$1,970

It is important to note that no extension of time is permitted that extends the period for response past the maximum 6 month statutory period. Responses received after the maximum 6 month statutory period will be held abandoned. 37 C.F.R. § 1.135.

Art Unit: 3632

Three examples are provided:

Example 1:

A complete response is filed four months and one day after the mailing date of an Office action. The Office action sets a 3 month shortened statutory period for response. The response must be accompanied by a fee in the amount of \$205 (for a small entity); \$410 for a large entity) for a 2 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 2:

A complete response is filed five months and one day after the mailing date of an Office action. The Office action sets a 2 month shortened statutory period for response. The response must be accompanied by a fee in the amount of \$725 (for a small entity); \$1,450 for a large entity) for a 4 month extension of time. The response must also contain a statement requesting "an extension of the period for response under 37 C.F.R. § 1.136(a)."

Example 3:

A complete response is filed six months and one day after the mailing date of an Office action. The Office action sets a 3 month shortened statutory period for response. The response is held abandoned even if accompanied by a fee and a request for an extension of time. Remember, extensions of time may not be used to extend the period for response past the maximum 6 month statutory period. 37 C.F.R. § 1.135.

Art Unit: 3632

IV. Certificate of Mailing

To ensure that the Applicant's response is considered timely filed, it is advisable to include a "Certificate of Mailing" on at least one page of the response. See 37 C.F.R. § 1.8. This "Certificate" should consist of the following statement:

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Applicant signature

Date

CONCLUSION AND CAVEAT

The above discussion is not intended to be an exhaustive list of all the topics that may be relevant to this particular Application. The information was provided to familiarize Applicant with the portions of a response that have historically caused problems for *pro se* inventors.

Furthermore, even if Applicant's response is in accordance with the information provided above, there is no guarantee that every requirement of the patent laws (35 U.S.C. §§ 1-376), patent rules (37 C.F.R. §§ 1.1-150.6), and Patent Office policy (M.P.E.P. §§ 101-2591) has been met. The adequacy of a response is determined on a case-by-case basis. See 37 C.F.R. § 1.111; M.P.E.P. § 714.02.

Art Unit: 3632

Specification

The abstract of the disclosure is objected to because (no more than 150 words needs to be deleted.. Correction is required. See MPEP § 608.01(b).

Claim Objections

Claim 5 objected to because of the following informalities: each of the claims should only consist of one sentence. Appropriate correction is required.

Claim 7 objected to because of the following informalities: "." Should be inserted after "pages turning".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-7 rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for two pads of hook or loop fasteners and the strap forming the other two pads of hook or loop fasteners, does not reasonably provide enablement for two identical mating pad of hook and loop

Art Unit: 3632

fasteners (which would mean 4 pads total= 2 pads of hook and 2 pads of loop) and two identical hook and loop fastening pad straps. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2, 4, 5, 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 recites the limitation "a steering wheel" in line 2. There is improper antecedent basis for this limitation in the claim. The "a" before "steering" should be deleted and a - the- should be inserted.

Claim 4 recites the limitation "said fastening means" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 3632

Claim 5 recites the limitation "mounted foldable shelf member" in line 1. There is insufficient antecedent basis for this limitation in the claim. The "a" should be deleted and "member".

Claim 6 recites the limitation "the pens" in line 2. There is insufficient antecedent basis for this limitation in the claim. "the" should be deleted and -a- should be inserted.

The claims have been rejected under 35 U.S.C. 112 for the above reasons. Please note that the Examiner may not have pointed out each and every example of indefiniteness. The applicant is required to review all the claim language to make sure the claimed invention is clear and definite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Malinski 5,060,581 in

Art Unit: 3632

view of Shioda 5,385,283 in view of Brennan 2,374,409 in view of Joye 5,642,674 and in further view of Gerald 3,747,889.

Malinski discloses a book holding device (Figure 1) comprising an upper filleted rectangle support plate (3), and a lower filleted rectangle support plate (1), a hinge (5), an attachment means (11), shelf (15). Malinski discloses all of the limitations of the claimed invention except for two identical straps and two identical hook and loop fasteners, a foldable shelf, two elastic bands, and two elastic loops. Shioda teaches that it is known to use two straps (24) and two identical mating pads of hook and loops (22). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Malinski to have substituted the two straps and two identical mating pads of hook and loops as taught by Shioda for the purpose of providing a better means of attachment. Brennan teaches of a foldable shelf (21). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Malinski in view of Shioda to have a foldable shelf as taught by Brennan for the purpose of folding the shelf out of the way when stored and to allow the upper and lower plates to be more compactly. Joye teaches that it is known to have elastic loops (16). It would have been obvious to one having ordinary skill in the art at the time of

Art Unit: 3632

the invention to have modified Malinski in view of Shioda in view of Brennan to have included the elastic loops as taught by Joye for the purpose of providing a means of holding utensils to the holding device. Gerald teaches that it is known to have elastic bands (21). It would have been obvious to one having ordinary skill in the art at the time of the invention to have modified Malinski in view of Shioda in view of Breennan in further view of Joye to have included the elastic bands as taught by Gerald for the purpose of providing a means of preventing pages of books from turning.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The prior art discloses conventional book holding device.

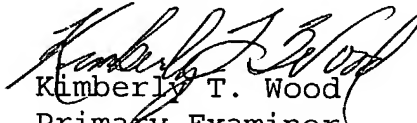
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Wood whose telephone number is 703-308-0538. The examiner can normally be reached on Monday-Thursday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leslie Braun can be reached on 703-308-2156. The fax phone number for the

Art Unit: 3632

organization where this application or proceeding is assigned is
703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Kimberly T. Wood
Primary Examiner
Art Unit 3632